

10. (Original) The apparatus of claim 9, wherein the enhancement mode transistor is a p-channel enhancement mode field effect transistor.

REMARKS

Claims 1-10 are pending in the present application and Applicants have amended claims 1 and 6. Applicants have also submitted a replacement drawing sheet to address the objection to the drawings. Applicants believe that no new matter has been added in this response.

Objections to the Drawings

The Examiner Objected to the drawings as failing to comply with 37 C.F.R. 1.84(p)(5) because they did not include description 100 and 200 in Figures 1-2. Applicants have provided a replacement sheet that has description 100 and 200 in Figures 1 and 2. Therefore, Applicants submit that the objection to the drawings has been addressed.

Response to 35 U.S.C. §103 Rejection

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable

expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Examiner rejected claims 1-10 under 35 U.S.C. §103(a) as being unpatentable over a dual Schottky diode device in view of Staffiere (U.S. Patent 6,137,192, hereafter the '192 patent). The Examiner found that the dual Schottky diode device contained all the limitations "except a FET coupled to the second source and an inverter for preventing a current flow from the second source when the first power is available." The Examiner then relied on the '192 patent to show; "wherein a FET is coupled to a second source and an inverter is provided for preventing a current flow from the second source when a first power is available (Figures 15, 16)." Applicants believe that the three basic criteria have not been met and that the claims are in condition for allowance.

Not all claim limitation taught or suggested by cited art

The dual Schottky diode device reference in view of the '192 patent, does not teach or suggest all of Applicants' claim limitations. The dual Schottky diode device reference and the '192 patent both describe switching circuit. The switching in the dual Schottky diode device occurs with diode biasing, while the switching in the '192 patent occurs with a control signal that turns on one transistor while turning another off. The control signal in the '192 patent is from a voltage detector, it is not the voltage from the Vcc. Rather it is a signal that is generated in response to the Vcc. Applicants in claim 1 and claim 6 require; "an inverter, coupled to a gate of a field effect transistor in a pinched-off condition and preventing a current flow from the secondary power source when the primary power source is available.

The '192 patent describes at column 10, lines 15-22, and shows in figure

16 that;

"[t]ransistor 350 has its drain coupled to the Vcc power supply and its source coupled to output load 330. The gate of transistor 350 is coupled to receiver the signal from voltage detector 320 via inverter 370. Transistor 360 has its drain coupled to embedded backup electrical energy storage device 310 and its source coupled to load 330. The gate of transistor 360 is coupled to receive signal 325 from voltage detector 320."

Thus, the '192 patent describes transistor 360 being coupled to the backup electrical energy storage device with the gate to the receive signal 325 from the voltage detector 320. The inverter in the '192 patent does not keep transistor 360 in a pinched-off condition, nor does the inverter prevent the current flow from the secondary power source as claimed by Applicants in independent claims 1 and 6. Further, there is no mention in the references about the secondary power source having a lower potential than a primary power source as contained in independent claims 1 and 6.

The Examiner the stated on page 4 of the final office action that "due to a typographical error, the inverter (370) in Figure 16 is illustrated with its orientation reversed." The Examiner is reading into the reference and re-engineering it. It could even be viewed that the '192 reference teaches away from how the Examiner is attempting to use the reference. The '192 reference had a lengthy certificate of correction, and there was no mention of Figure 16. Therefore, the reference if combined with FIG. 1 of the current application would be inoperable.

Therefore, the dual Schottky diode device when combined with the '192 patent fails not suggest all of Applicants' claim limitations contained in independent claims 1 and 6.

Suggestion or motivation to combine

A prima facie case of obviousness requires that there be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings of the dual Schottky diode device with the '192 patent. The combination of the dual Schottky diode device with the '192 patent fails to describe all the elements claimed by the Applicants, thus there can be no motivation to combine because at least one element would still be missing. Any such objective reason can only be found in the teaching of the application in suit. Even if the mere fact that the prior art could be modified as proposed by the Examiner, it is not sufficient to establish a prima facie case of obviousness, In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992).

Further, both the dual Schottky diode device and the '192 patent are both switching circuits. There is no reason to combine two switching circuit in one circuit. Further, such a combination using the teachings of the cited art requires a voltage detector element that increases the complexity and cost of any resulting circuits and would not motivate any such combination.

Therefore, the cited art cannot be combined because all the elements of Applicants' amended claims 1 and 6 are not found in the cited references and there is not motivation to have a circuit with two switching circuits and the added complexity contained in the '192 patent.

There must be a reasonable expectation of success

Prima facie obviousness requires that there must be a reasonable expectation of success when prior art is modified or combined. There is no reasonable expectation of success in

achieving the invention claimed when the dual Schottky diode device is modified with the teachings of the '192 patent.

As discussed above, the combination of cited art does not contain all the elements of Applicants' claims 1 and 6. Unless all the elements are taught by the references, there can be no success in combining the cited references. Therefore, there is no reasonable expectation of success if and attempt is made to combine the cited references. Further, the Examiner stated that he had to change components in Figure 16 of the '192 patent in order to make it work in manner to cite against the Applicants.


In summary, the combination of the above references does not meet the three basic criteria to establish a prima facie case of obviousness and Applicants respectfully submit that amended claims 1 and 6 are in condition for allowance. Claims that depend from allowable independent claims are allowable because they contain all the elements from the allowable claims they depend from. Therefore dependent claims 2-5 and 7-10 are also in condition for allowance.

Conclusion

In view of the foregoing discussion, Applicants respectfully submit that claims 1-10, as presented, are in a condition for allowance, which action is earnestly solicited.

Respectfully submitted,

Dated: Apr 122, 2008


Gregory B. Gulliver, Reg. No. 44,138
Attorney for Assignee
The Eclipse Group, LLP
100 Tri-State International, Suite 128
(847) 282-3551 Telephone
(818) 332-4205 Fax

Customer No.: 34408